



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,360	06/16/2006	Claudio Giacometti	71975	7251
23872	7590	12/08/2009		
MCGLEW & TUTTLE, PC				
P.O. BOX 9227				
SCARBOROUGH STATION				
SCARBOROUGH, NY 10510-9227				
EXAMINER				
TOLIN, MICHAEL A				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
12/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/552,360

**Applicant(s)**

GIACOMETTI, CLAUDIO

**Examiner**

MICHAEL A. TOLIN

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 19-24, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 19-24, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-3-05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-14 and 19-24 are objected to because of the following informalities.

Appropriate correction is required.

Regarding claim 1, the examiner suggests deleting the second instance of "rotating" in line 10 to correct a grammatical error.

Regarding claim 2, the examiner suggests changing "roller" to "rollers" to correct a grammatical error.

Regarding claim 19, the examiner suggests changing "web" to "webs" to correct a grammatical error.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14, 19-24 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

While Applicant's specification clearly indicates preheating prior to contacting either roller, there is no indication of preheating prior to contacting one of the rollers. The new language is satisfied by preheating on one roller prior to contacting the other roller. There is no such teaching in Applicant's original disclosure or claims. Accordingly, it does not appear Applicant possessed this new limitation at the time the invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 19, 23, 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giacometti (US 5709829) in view of Muth (WO 03/004229 A1 referencing US 2004/0209041 as an English-language equivalent), Schulz (US 5913997) and Cruise (US 5874159).

The references are applied as in numbered paragraph 5 of the previous office action, mailed 19 May 2009. In view of the new claim language, Muth, Schulz and Cruise have been applied here collectively instead of in the alternative as in the previous office action. The collective teachings provide a wide variety of reasons for

providing a preheating step in the process of Giacometti as set forth in the previous office action and further explained below.

The amendment to claim 1 further limits the preheating step to require that preheating is performed prior to the web material contacting one of the rollers. It is noted that this does not preclude preheating on one of the rollers prior to contacting the other roller, as suggested by Muth. Furthermore, Schulz and Cruise clearly suggest preheating prior to contact with either roll. Accordingly, this new limitation is satisfied by the combination of these references with the primary reference to Giacometti to provide motivation to add a preheating step in the process of Giacometti for the reasons set forth in the previous office action, mailed 19 May 2009.

Claim 35 is satisfied for the reasons provided above.

6. Claims 6 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giacometti in view of Muth, Schulz and Cruise as applied to claims 1-5, 19, 23, 24 and 35 above, and further in view of Dettmer (WO 99/25911 referencing US 6395211 as an English-language equivalent).

Dettmer is applied as in numbered paragraph 6 of the previous office action.

7. Claims 7-9, 20-22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giacometti in view of Muth, Schulz and Cruise, and further in view of Dettmer as applied to claims 6 and 10-14 above, and further in view of Pike (US 5382400).

Pike is applied as in numbered paragraph 7 of the previous office action.

### ***Response to Arguments***

8. Applicant's arguments filed 19 August 2009 have been fully considered but they are not persuasive.

Applicant argues Giacometti fails to teach or suggest the combination of preheating prior to contacting with a first and second roller. The examiner agrees. Such was acknowledged on page 4 of the previous office action, mailed 19 May 2009. However, the argument is not persuasive because Muth, Schulz and Cruise have been applied to provide motivation for adding the claimed step of preheating prior to perforating between rollers in the manner suggested by Giacometti. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments against Muth are not persuasive because the claims do not preclude preheating on a first roller before the web contacts a second roller. Such is clearly shown by Muth.

Applicant argues Schulz and Cruise do not teach the combination of preheating and perforating. Applicant further argues that these references only disclose heating prior to a bonding treatment. The examiner acknowledges that these references do not teach the combination of preheating and perforating. However, the rejection is based on a combination of references. The primary reference to Giacometti is clearly directed

to perforating by thermal treatment between rollers wherein one or both of the rollers is heated (column 2, lines 40-50). Schulz and Cruise have been applied collectively with Muth to provide motivation to add a preheating step prior to the perforation taught by Giacometti. In particular, Schulz teaches preheating prior to thermomechanical treatment of a web in order to achieve a variety of advantages including very uniform treatment, increased flexibility in processing conditions at various line speeds and web materials, optimizing the thermomechanical treatment, and providing precise temperature control (column 2). While the examiner acknowledges that Schulz indicates that the thermomechanical treatment may be a bonding operation, there is no teaching in Schulz that the above noted advantages are only directed to a bonding operation. Furthermore, Schulz indicates that the thermomechanical treatment may include processing between heated rolls (column 3, lines 25-31). Since Giacometti's perforation is directed to a thermomechanical treatment between heated rolls, one of ordinary skill in the art would have reasonably expected that one or more of the advantages taught by Schulz of preheating prior to thermomechanical treatment between heated rolls would have been achieved in combining Giacometti's thermomechanical perforation treatment with preheating in accordance with the teachings of Schulz. Applicant has not provided any evidence that none of the advantages suggested by Schulz would be achieved by combining preheating with Giacometti's perforation. Similarly, Cruise indicates preheating prior to processing between heated rolls allows an increase in line speed because the opposed rolls do not have to heat the fabric as much (column 5, line 64-67; column 6, lines 1-8). Since

Giacometti is also directed to processing between heated rolls, one of ordinary skill in the art would have reasonably expected to also achieve a similar increase in line speed by preheating in accordance with the teachings of Cruise. Applicant has not presented any evidence to the contrary.

Applicant argues that preheating advantageously reduces the time acquired for perforation, thus allowing high line speed as well as several other advantages. This argument is not persuasive because, as noted above, Cruise recognizes that preheating allows increased line speed because the preheating reduces the amount of heating required in subsequent processing between heated rolls. Thus, in view of Cruise, this advantage is recognized by the prior art and is not considered unexpected. As to the other advantages noted by Applicant, for the reasons provided above, Schulz and Cruise provide strong motivation for adding a preheating step to the process of Giacometti. Accordingly, advantages which result from this combination cannot be the basis for patentability because the prior art already suggests the combination for the reasons provided above and the advantages noted by Applicant naturally flow from this combination. Furthermore, the claims do not recite a degree of mechanical stress on the web material, a particular pressure between the rollers, a particular height of protuberances, or a particular thickness of the finished product. Accordingly, these arguments do not appear to be commensurate in scope with the claims.

With regard to Dettmer, Dettmer was applied for a teaching that pre-bonding prior to perforating is advantageous in that fibers are held together and do not prematurely or individually come into contact with the embossing roller which produces perforations.



As noted above, Muth, Schulz and Cruise were applied for the particular preheating limitation.

With regard to Pike, Pike was applied for a variety of well known nonwoven web processing methods set forth on pages 7-10 of the previous office action. As noted above, Muth, Schulz and Cruise were applied for the particular preheating limitation.

Applicant's arguments with respect to new claims 35 and 36 are not persuasive for the reasons provided above in the new grounds of rejection applied against these claims.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The new claims and new language added to claim 1 necessitated the new grounds of rejection applied above.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. TOLIN whose telephone number is (571)272-8633. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Tolin/  
Patent Examiner, Art Unit 1791